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Support for Amendment:

Claim 1 is amended to include the features of canceled claim 3 and canceled claim 18. In addition, claim 1 is amended to characterize the continuous thin film as a liquid lubricant composition comprising an emulsion of an oil phase and an aqueous phase. It is pointed out that this language more clearly reflects the language of original claim 2.

Claims 10 and 11 are amended so that they depend on independent claim 1 rather than canceled claim 2.

No new matter is introduced by this Amendment, and entry thereof is requested. Upon entry, claims 1, 4-17, 19, 20, and 74 are active in this application.

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REMARKS

The outstanding Office Action contends that the phrase "an emulsion lubricant" is not supported by the patent application and, therefore, "the effective filing date for all claims of the current application is considered to be 8/11/2003." This holding is clearly incorrect. The claims of the above-identified patent application are clearly entitled to a priority date at least as early as June 16, 2002.

It is submitted that the phrase "emulsion lubricant" is clearly supported by the above-identified patent application and is entitled to a priority date at least as early as June 16, 2002. Nevertheless, claim 1 has been amended to more clearly correspond to the features of original and canceled claim 2.

In view of the above comments, the examiner is requested to clearly indicate that the claims of the above-identified patent application are at least entitled to a priority date as early as June 16, 2002.

The outstanding Office Action includes an objection to claims 10 and 11 on the grounds that they depend on claim 2. Claims 10 and 11 are amended so that they depend on claim 1. Accordingly, withdrawal of this objection is requested.

Obviousness-Type Double Patenting Rejections

The outstanding Office Action includes five rejections based on obviousness-type double patenting in view of the claims of U.S. Patent Number 6,509,302, U.S. Patent Number 6,673,753, U.S. Patent Number 6,780,823, U.S. Patent Number 6,806,240, and U.S. Patent Number 6,809,068. Applicants will submit in the next 2-3 weeks a Terminal Disclaimer document, which, when it is submitted, will render these five rejections moot. Accordingly, withdrawal of these five rejections is requested.

It should be understood that the filing of the Terminal Disclaimer should not be construed as agreement with the appropriateness of the obviousness-type double patenting rejections. The Terminal Disclaimer is submitted to advance prosecution.

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Provisional Rejection Based on Obviousness-Type Double Patenting

The outstanding Office Action includes a provisional rejection based on obviousness-type double patenting over U.S. Patent Publication Number US 2004/0058829. Applicants will submit in the next 2-3 weeks a Terminal Disclaimer document, which, when it is submitted, will render this provisional rejection moot. Accordingly, withdrawal of this provisional rejection is requested.

It is pointed out that the filing of the Terminal Disclaimer document should not be construed as agreement with the appropriateness of the provisional obviousness-type double patenting rejection. The Terminal Disclaimer is submitted to advance prosecution.

Rejections Under 35 U.S.C. § 103(a)

The outstanding Office Action includes six rejections under 35 U.S.C. § 103(a). These rejections are:

- (1) A rejection of claims 1, 5-8, 12-14, and 74 under 35 U.S.C. § 103(a) over U.S. Patent Number 6,509,302 (Lee et al. '302);
- (2) A rejection of claims 1, 3-20, and 74 under 35 U.S.C. § 103(a) over U.S. Patent Number 6,673,753 (Pearson Hei et al.);
- (3) A rejection of claims 1, 3-7, 12-17, and 74 under 35 U.S.C. § 103(a) over U.S. Patent Number 6,780,823 (Li et al. '823);
- (4) A rejection of claims 1, 3-20, and 74 under 35 U.S.C. § 103(a) over U.S. Patent Number 6,806,240 (Hei et al. '240);
- (5) A rejection of claims 1, 3, 5, 15, 16, and 74 under 35 U.S.C. § 103(a) over U.S. Patent Number 6,809,068 (Küpper et al.); and
- (6) A rejection of claims 1, 3-20, and 74 under 35 U.S.C. § 103(a) over U.S. Patent Publication Number US 2004/0058829 (Hei et al. '829).

These six rejections under 35 U.S.C. § 103(a) should be withdrawn. According to 35 U.S.C. § 103(c)(1):

"Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

It is submitted that all of the documents relied upon in the rejections under 35 U.S.C. § 103(a) were either owned by the assignee (Ecolab Inc.) or subject to an obligation of assignment to the assignee (Ecolab Inc.). As a result, it is submitted that the rejections under 35 U.S.C. § 103(a) should be withdrawn.

In view of the above comments, withdrawal of the rejections under 35 U.S.C. § 103(a) is requested.

Rejections Under 35 U.S.C. § 102

The outstanding Office Action includes several rejections under 35 U.S.C. § 102. Each of these rejections is addressed below.

(1) Claims 1, 3-20, and 74 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent Number 6,427,826 (Lee et al. '826). This rejection is traversed on the grounds that Lee et al. '826 does not qualify as a prior art reference under 35 U.S.C. § 102(b).

The above-identified patent application is entitled to a priority date at least as early as June 16, 2002. Lee et al. '826 published on August 6, 2002. Accordingly, Lee et al. '826 is not available as a reference under 35 U.S.C. § 102(b), and withdrawal of this rejection is requested.

(2) Claims 1, 5-8, 12-14, and 74 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Number 6,509,302 (Lee et al. '302). This rejection is traversed.

The claims are directed to a method of lubricating the interface between a container and a moving conveyor surface in the substantial absence of foamed lubricant and lubricant run off.

The method includes steps of forming a continuous film on a container contact surface of a conveyor, and moving a container on the conveyor surface in order to transport the container from a first location to a second location. The continuous film is of a liquid lubricant composition comprising an emulsion of an oil phase and an aqueous phase, the oil phase comprising silicone, and wherein the emulsion contains about 5 to 50 wt.% of the aqueous phase, and the continuous thin film of the lubricant is placed on the surface of the moving conveyor forming a lubricated area and an unlubricated margin on the conveyor, and wherein the edge of the conveyor comprises the unlubricated margin.

It is submitted that Lee et al. '302 fails to disclose the presently claimed method. Accordingly, withdrawal of the rejection is requested.

(3) Claims 1, 3-20, and 74 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Number 6,673,753 (Pearson Hei et al.). This rejection is traversed.

The claims are directed to a method of lubricating the interface between a container and a moving conveyor surface in the substantial absence of foamed lubricant and lubricant run off. The method includes steps of forming a continuous film on a container contact surface of a conveyor, and moving a container on the conveyor surface in order to transport the container from a first location to a second location. The continuous film is of a liquid lubricant composition comprising an emulsion of an oil phase and an aqueous phase, the oil phase comprising silicone, and wherein the emulsion contains about 5 to 50 wt.% of the aqueous phase, and the continuous thin film of the lubricant is placed on the surface of the moving conveyor forming a lubricated area and an unlubricated margin on the conveyor, and wherein the edge of the conveyor comprises the unlubricated margin.

It is submitted that Pearson Hei et al. fails to disclose the presently claimed method. Accordingly, withdrawal of this rejection is requested.

(4) Claims 1, 3-7, 12-14, and 74 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Number 6,780,823 (Lee et al. '823). This rejection is traversed.

It is pointed out that Lee et al. '823 is the patent that issued from the parent of the above-identified patent application. Accordingly, it is submitted that it is not available as a prior art

reference under 35 U.S.C. § 102(e). Accordingly, withdrawal of the rejection over Lee et al. '823 is requested.

(5) Claims 1, 3-20, and 74 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Number 6,806,240 (Hei et al. '240).

The claims are directed to a method of lubricating the interface between a container and a moving conveyor surface in the substantial absence of foamed lubricant and lubricant run off. The method includes steps of forming a continuous film on a container contact surface of a conveyor, and moving a container on the conveyor surface in order to transport the container from a first location to a second location. The continuous film is of a liquid lubricant composition comprising an emulsion of an oil phase and an aqueous phase, the oil phase comprising silicone, and wherein the emulsion contains about 5 to 50 wt.% of the aqueous phase, and the continuous thin film of the lubricant is placed on the surface of the moving conveyor forming a lubricated area and an unlubricated margin on the conveyor, and wherein the edge of the conveyor comprises the unlubricated margin.

It is submitted that Hei et al. '240 fails to disclose the presently claimed method. Accordingly, withdrawal of the rejection over Hei et al. '240 is requested.

(6) Claims 1, 3, 5, 15, 16, and 74 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Number 6,809,068 (Küpper et al.). This rejection is traversed.

It is believed that the statement of the rejection in the outstanding Office Action includes a typographical error. The rejection refers to U.S. Patent Number 6,809,608. It is assumed that the Office Action meant to refer to U.S. Patent Number 6,809,068. This response is based upon the assumption that there is a typographical error in the Office Action.

The claims are directed to a method of lubricating the interface between a container and a moving conveyor surface in the substantial absence of foamed lubricant and lubricant run off. The method includes steps of forming a continuous film on a container contact surface of a conveyor, and moving a container on the conveyor surface in order to transport the container from a first location to a second location. The continuous film is of a liquid lubricant composition comprising an emulsion of an oil phase and an aqueous phase, the oil phase

comprising silicone, and wherein the emulsion contains about 5 to 50 wt.% of the aqueous phase, and the continuous thin film of the lubricant is placed on the surface of the moving conveyor forming a lubricated area and an unlubricated margin on the conveyor, and wherein the edge of the conveyor comprises the unlubricated margin.

It is submitted that Küpper et al. fails to disclose the presently claimed method. Accordingly, withdrawal of the rejection over Küpper et al. is requested.

(7) Claims 1, 3-20, and 74 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Publication Number US 2004/0058829 (Hei et al. '829). This rejection is traversed.

The claims are directed to a method of lubricating the interface between a container and a moving conveyor surface in the substantial absence of foamed lubricant and lubricant run off. The method includes steps of forming a continuous film on a container contact surface of a conveyor, and moving a container on the conveyor surface in order to transport the container from a first location to a second location. The continuous film is of a liquid lubricant composition comprising an emulsion of an oil phase and an aqueous phase, the oil phase comprising silicone, and wherein the emulsion contains about 5 to 50 wt.% of the aqueous phase, and the continuous thin film of the lubricant is placed on the surface of the moving conveyor forming a lubricated area and an unlubricated margin on the conveyor, and wherein the edge of the conveyor comprises the unlubricated margin.

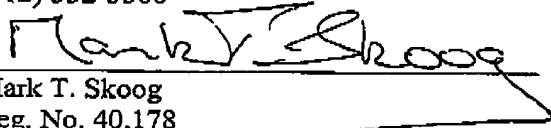
It is submitted that Hei et al. '829 fails to disclose the presently claimed method. Accordingly, withdrawal of the rejection over Hei et al. '829 is requested.

In view of the above comments, it is believed that this application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,

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